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IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

NOTICE OF MOTION NO.2391 OF 2004
IN
SUIT NO.2455 OF 2004

M/s.Mauser Werke GmbH & Anr. ... Plaintiffs

V/s.

M/s.Supreme Die Works & Ors. ... Defendants

Mr.Janak Dwarkadas with Mr.Rahul chitnis i/b Ms.Yashoda Bhat and S.P. Vijayaragavan for Plaintiffs

Mr.Milind Vasudeo i/b ANS Law Associates for Defendant Nos.3 and 4

Mr.Amit Pradhan i/b ANS Law Associates for Defendant Nos.5 and 6

CORAM: **SMT.NISHITA MHATRE, J.**

DATED: **JULY 25, 2006**

P.C.:

. Plaintiff No.1 is a Company incorporated in Germany. It is engaged in the business of developing and manufacturing plastic drums, polycans, jerrycans, bottles, etc. Plaintiff No.1 has acquired a patent being No.179257 for the manufacture of ‘Narrow Mouth Drums’ which have a stackable barrel. The patent has been acquired on 4.2.1991 as indicated in Exhibit A1 to the plaint. It has also acquired patent NO.179292 in respect of manufacturing a "Barrel Having A Bung". This patent was acquired by Plaintiff No.1 on 8.2.1991.

2. Plaintiff No.2 then entered into an agreement with Plaintiff No.1. The Patents owned by Plaintiff No.1 were licensed to Plaintiff No.2. Plaintiff No.2

has been manufacturing and marketing the Narrow Mouth Drum, using the two patents aforesaid from 1991.

3. According to the Plaintiffs, Defendant Nos.1 and 2 manufactured the mould for the drums using the designs given by the plaintiffs based on the patents owned by them. These designs according to the Plaintiffs, were given to Defendant Nos.1 and 2 in confidence with an understanding that the designs would be used only for making moulds for the manufacture of the drums for the plaintiffs. The Plaintiffs allege that Defendant No.2 manufactured the moulds and gave these designs and moulds to the other defendants. Defendant Nos.3 and 4 manufactured the drums using these designs of the plaintiffs in collusion with Defendant Nos.1 and 2 which are indicated at Exhibit ‘L’ whereas Defendant Nos.5 and 6 manufactured the drums depicted at Exhibit ‘N’.

4. The plaintiffs have produced a report from the Indian Institute of Technology, Mumbai (for short, ‘IIT’). This report, according to the Plaintiffs, supports their case that Defendant Nos.3 to 6 have manufactured drums which are identical or in any event deceptively similar to the terms manufactured by the plaintiffs. The report indicates that the design and constructions of the samples manufactured by Defendant Nos.3 to 6 match the design and novelty features covered by both the patents owned by the plaintiffs. This opinion has been submitted by the Associate Professor of

the Department of Mechanical Engineering of the IIT.

5. The Plaintiffs therefore, have filed the present Suit and have sought an injunction against the Defendants from using, manufacturing, selling or distributing the Narrow Mouth Drum manufactured by them by using or applying the patents owned by the plaintiffs and thus imitating or reproducing the plaintiffs products. The plaintiffs have also a grievance that their designs registered on 15.10.1990 for the Narrow Mouth Drum and on 1.9.1992 for the Open Top Drum have been infringed. The Plaintiffs have, therefore, sought an injunction against the defendants from manufacturing such drums. The Plaintiffs are therefore, claiming interim reliefs in terms of prayer clauses (a), (b) and (e) of the Motion.

6. Defendant Nos.3 to 6 (hereinafter referred to as 'the Defendants') contend that expert opinion obtained by them from the Indian Institute of Packaging shows that the products manufactured by the Plaintiffs and the products manufactured by the Defendants are dissimilar and are not based on the registered patents or designs.

7. The defendants state that they had exhibited their products at the trade fair in 2003. The Plaintiffs were therefore, aware of their products in 2003 itself and ought to have initiated steps immediately rather than waiting for more than a year

before the suit was filed. According to the Defendants, they had been manufacturing these products since 1991. The defendants also contend in reply to the Motion that Defendant Nos.1 and 2 had not supplied any moulds to them. The Defendants assert that they have manufactured their products based on their own designs and have not copied the plaintiffs' products.

8. The learned Counsel appearing for the Plaintiffs points out that the aforesaid two patents owned by the plaintiffs are registered and the Court must step in if it finds that there is an infringement of the patent rights. The learned Counsel submits that the conduct of the defendants is not bonafide. Ad-interim relief was granted appointing the Court Receiver for taking inventory of the barrels, moulds and joints and other material. According to the Plaintiffs, the material had been removed by the Defendants to some other place before the Court Receiver visited the premises. This conduct, contend the Plaintiffs, shows the malafides of the Defendants.

9. The Plaintiffs are not pressing the Motion against Defendant Nos.1 and 2 in view of an earlier judgment of this Court.

10. Defendant Nos.3 and 4 represented by Mr.Vasudeo contend that the report of the IIT is not sacrosanct and the defendants must be permitted to cross-examine the

witness before any relief is granted to the plaintiff on the basis of the expert opinion. The learned Counsel contends that Defendant Nos.1 and 2 did not at any point of time show the designs of the plaintiff to them for the defendants to manufacture the same. The Defendants have contended that no case of infringement of the patents or the design have been clearly set up. The Defendants have also contended that Plaintiff No.2 is not entitled to maintain the present suit and consequently Plaintiff No.1 also would have no cause of action. The learned Counsel has contended there is an inordinate delay in approaching this Court and therefore, no interim relief should be granted and the Motion should be dismissed with costs.

11. The report of the Indian Institute of Packaging on which the Defendants rely, has been issued by a person who is not qualified to depose regarding the patentability of the product. Therefore, the question of accepting this report at this interim stage does not arise. The author of the report relied on by the Plaintiffs being a Mechanical Engineer and working in the Department of Mechanical Engineering, IIT, Mumbai would prima facie be qualified to opine as to whether the product manufactured by the defendants are identical or deceptively similar to those manufactured by the plaintiffs. In my view, the plaintiffs have shown prima facie that their patents have been infringed by the defendants. The Plaintiffs would therefore in my

opinion be entitled to certain interim reliefs.

12. As regards the designs of the products the plaintiffs have made out a case to show that their designs have been copied by the defendants for manufacturing their drums. In any event, the Plaintiffs would be entitled to an injunction since it would be appropriate to restrain the defendants from manufacturing drums which are deceptively similar or similar to the products of the plaintiffs. It is obvious that the Defendants have manufactured their drums either based on the designs of the plaintiffs obtained from Defendant No.2, the mould maker or on the basis of the designs supplied by them which are deceptively similar to those of the plaintiffs. The plaintiffs' registration of patents is in the year 1991 and, therefore, by reason of antiquity, the plaintiffs would be entitled to interim reliefs. There is no dispute that Plaintiff No.1 is an international user of its patents and designs. A Court in Germany has upheld the patentability of the products. In such circumstances, in my opinion, the Plaintiffs would be entitled to interim relief.

13. It is well settled as seen from the judgment of the Calcutta High Court in the case of *Boots Pure Drug Co. v/s. May & Baker* reported in **1952 Cal.W.N. 253** that before the Court grants temporary injunction against the infringement of a patent right, the

Plaintiffs would have to prove 3 things: (a) that the Plaintiff prima facie has a right over a valid patent (b) that there prima facie is evidence on record to show that there has been infringement and (c) the balance of convenience is in plaintiff's favour. The Calcutta High Court has observed that if a patent is a new one a mere challenge at the bar would be quite sufficient for the refusal of an interim injunction. However, if the patent is sufficiently old and there has been an actual user, the Court could proceed on the presumption that the patent is a valid one and grant a temporary injunction. The Madras High Court in the case of *V.Manicka Thevar v/s. M/s.Star Plough Works*, **AIR 1965 MADRAS 327** has held that the burden of proving an infringement of patent is on the plaintiffs. No temporary injunction can be granted when the patents is a recent one.

14. In the case before me, the patents are undisputedly registered in 1991 and have by reason of their antiquity attained validity. It must be presumed that these patents are valid and the plaintiffs would be entitled to an injunction.

15. In the circumstances, the Notice of Motion is allowed in terms of prayer clauses (a), (b) and (e).

16. Mr.Vasudeo seeks a stay of the order for a period of two weeks. This application is vehemently

opposed by Mr.Chitnis. Stay granted for a period of two weeks from today.